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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/687,518 | 10/13/2000 | Rich Karstens | PALM-3513 | 7809 |

7590 10/21/2003

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| EXAMINER |
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LE, DANH C

| ART UNIT | PAPER NUMBER |
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2683

DATE MAILED: 10/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,518

Applicant(s)

KARSTENS ET AL.

Examiner

DANH C LE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 14 recites the limitation "task of said operating system" in line 3.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1, 3-10, 13-14, 16-20, 23, 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of August (US 5,671,267).

As to claim 1, Yang teaches in a portable electronic device, a method for automatically delivering a phone call (figure 1), said method comprising the steps of:

monitoring for incoming phone calls by a background task of said operating system of said device, said background task interfacing directly with the telephony functionality of said device, said background task always active, said operating system including at least one application (col.5, line 35 to col.7, line 8, application (col.2, lines 37-46, OSD));

detecting said incoming phone call by said background task (col.5, line 35 to col.7, line 8);

notifying said operating system of said incoming phone call by said background task (col.5, line 35 to col.7, line 8); and

notifying a user of said device of said incoming phone call by the background task irrespective of the user's activity on said device (col.5, line 35 to col.7, line 8).

Yang fails to teach the application (TV mode) still continues when the user answering the incoming call. August teaches the application still continues (TV mode) when the user answering the incoming call (col.11, line 19-col.12, line 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of August into the system of Yang in order to enhance the system performance of the displaying received message of portable television phone in which the user simultaneous watches the TV and talks with other party at the same time.

As to claim 3, the combine of Yang and August teaches the method as recited in Claim 1 further comprising answering said incoming phone call by the user (August, col.11, line 19-col.12, line 6).

As to claim 4, Yang teaches the method as recited in Claim 32 wherein said notifying the operating system comprises operating to notify said user of said device of said incoming phone call by said background task irrespective of said user's activity on said device, provided said graphical user interface is blocked (col.5, line 35 to col.7, line 8).

As to claim 32, Yang teaches the method as recite in claim 1 where said application is a graphical user interface (col.2, lines 37-46, OSD)

As to claim 5, Yang teaches the method as recited in Claim 32 wherein said notifying said operating system comprises updating said graphical user interface with an image of a cellular phone keypad and digitry, provided said graphical interface is not blocked (col.5, line 35 to col.7, line 8).

As to claim 6, Yang teaches the method as recited in Claim 5, wherein said background task operates to notify the user of said device of said incoming phone call irrespective of the user's activity on said device (col.5, line 35 to col.7, line 8).

As to claim 7, Yang teaches the method as recited in Claim 1 wherein notifying said user is performed by activating a ringer on said device (col.6, lines 62-col.7, line 8).

As to claim 8, Yang teaches the method as recited in Claim 1 wherein said notifying said user is performed by activating a vibrator on said device (col.5, line 51-col.6, line 15).

As to claim 9, Yang teaches the method as recited in Claim 1 wherein notifying said user is performed by activating LEDs on said device (col.5, line 51-col.6, line 15).

As to claim 10, Yang teaches the method as recited in Claim 3 wherein said answering is performed by pressing a button on said device (col.6, lines 36-46).

As to claim 13, Yang teaches the method as recited in Claim 3 wherein said answering is performed by acknowledging an incoming call display on said graphical user interface (col.2, lines 37-46).

As to claim 14, Yang teaches a method for automatically delivering a phone call to a device (figure 1 and col.5, line 35 to col.7, line 8), said method comprising:

for incoming phone calls by a task of said operating system of said device, said task interfacing directly with the telephony functionality of said device, said task always remaining active irrespective of the activities of said operating system;

receiving said incoming phone call by said task; and

said task notifying a user of said device of said incoming phone call irrespective of said users activity on said device.

Yang fails to teach the application (TV mode) still continues when the user answering the incoming call. August teaches the application still continues (TV mode) when the user answering the incoming call (col.11, line 19-col.12, line 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of August into the system of Yang in order to enhance the system performance of the displaying received message of portable television phone in

which the user simultaneous watches the TV and talks with other party at the same time.

As to claim 16, the limitation of the claim is the same limitation of claim 3
Therefore, the claim is interpreted and rejected as set forth in the claim 3.

As to claim 17, the limitation of the claim is the same limitation of claim 7
Therefore, the claim is interpreted and rejected as set forth in the claim 7.

As to claim 18, the limitation of the claim is the same limitation of claim 8
Therefore, the claim is interpreted and rejected as set forth in the claim 8.

As to claim 19, the limitation of the claim is the same limitation of claim 9
Therefore, the claim is interpreted and rejected as set forth in the claim 9.

As to claim 20, the limitation of the claim is the same limitation of claim 10
Therefore, the claim is interpreted and rejected as set forth in the claim 10.

As to claim 23, Yang teaches a system for automatically delivering a phone call to a device (figure 1 and col.5, line 35 to col.7, line 8), said system comprising:

a processor (30) coupled to a bus and a display screen coupled to said bus; a cellular phone mechanism;

a memory unit (28 and col.5, lines 4-26) coupled to said bus and having stored therein an operating system executed by said processor and a background task executed by said processor, said operating system including at least one graphical user interface (col.2, lines 37-46, OSD); where said background task performs to the steps of monitoring for incoming phone calls by a background task of said operating system of said device, said background task interfacing directly with the telephony

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functionality of said device, said background task always active, said operating system including at least one graphical user interface (col.2, lines 37-46, OSD);

detecting said incoming phone call by said background task (col.5, line 35 to col.7, line 8);

notifying said operating system of said incoming phone call by said background task (col.5, line 35 to col.7, line 8); and

notifying a user of said device of said incoming phone call by said background task irrespective of the user's activity on said device (col.5, line 35 to col.7, line 8).

Yang fails to teach the application (TV mode) still continues when the user answering the incoming call. August teaches the application still continues (TV mode) when the user answering the incoming call (col.11, line 19-col.12, line 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of August into the system of Yang in order to enhance the system performance of the displaying received message of portable television phone in which the user simultaneous watches the TV and talks with other party at the same time.

As to claim 27, 28, Yang teaches the system as recited in Claim 23 wherein said background task monitors and receives for said incoming phone calls (col.5, line 35 to col.7, line 8).

As to claim 29, the limitation of the claim is the same limitation of claim 13. Therefore, the claim is interpreted and rejected as set forth in the claim 13.

As to claim 30, the limitation of the claim is the same limitation of claim 4

Therefore, the claim is interpreted and rejected as set forth in the claim 4.

As to claim 31, the limitation of the claim is the same limitation of claim 5

Therefore, the claim is interpreted and rejected as set forth in the claim 5.

As to claim 33, the limitation of the claim is the same limitation of claim 32

Therefore, the claim is interpreted and rejected as set forth in the claim 32.

2. Claims 2, 15, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang and August in view of Hawkins (6,516,202).

As to claims 2, 15, 24, Yang and August teaches method as recited in Claim 1. Yang and August fails to teach the portable electronic device is a palmtop computer system. Hawkins teaches the portable electronic device is a palmtop computer system (figure 3A). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Hawkins into the system of Yang and August in order to organize designed for a cellular phone with mobile computer.

3. Claims 11, 12, 21-22, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang and August in view of Baranowski (US 6,370,401).

As to claims 11-12, 21-22, 25-26, Yang and August teaches the method as recited in Claim 3 wherein step e) is performed by pressing a button on the keypad. Yang and August fails to teach a headset and earbud coupled to said device. Baranowski teaches a headset and earbud coupled to said device (col.2, lines 7-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

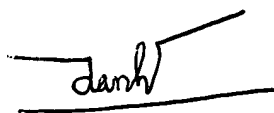
invention was made to provide the teaching of Baranowski into the system of Yang and August in order to enhance system performance of the portable television phone.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C LE whose telephone number is 703-306-0542. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Danh C.Le



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